



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,990	10/18/2000	Steven Benjamin Davis	2237.1 CONT.11	2111

5514 7590 10/05/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

WASYLCHAK, STEVEN R

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,990

Applicant(s)

DAVIS ET AL.

Examiner

Steven R. Wasylchak

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-46 is/are pending in the application.
- 4a) Of the above claim(s) 20-32;43-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (US 5,850,442).

Claims:

33. A business process for creating a secure contract over a network, comprising the steps of:

generating a contract agreement, comprising the steps of determining a contract rule set, determining a set of expectations for one or more contracting parties, and determining potential contract outcomes;/col 7, L46-63; fig 22,24

receiving initial conditions for contract generation from the one or more contracting parties;fig 22

carrying out contract activity according to the contract rule set such that the one or more contracting parties act in a synchronized manner according to the contract rule set and the set of expectations;/fig 23,24

generating a non-refutable contract log detailing all contract transactions;/fig 7(700)

Art Unit: 3624

generating a theoretical contract log detailing expected contract transactions based on the contract rule set, the set of expectations, and the initial conditions; and/fig 7(700); fig 23-25

Muftic does not explicitly disclose verifying the contract transactions as recorded in the contract log by comparing the contract transactions in the contract log to the expected contract transactions in the theoretical contract log.

Official notice is taken that this feature is old and well known in the e-commerce art and / or retail art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of checking those potential or theoretical contracts that have an expiration date do not lapse.

34. The business process according to Claim 33, wherein after the process is completed, financial transactions occur based upon the secure contract./ fig 24,25

35. The business process according to Claim 33, where the contract activities over the network are non-refutable./fig 27,28,30

36. The business process according to Claim 35, where one or more digital signatures are used to provide non-refutable identification of the one or more contracting parties./fig 22, 23

Art Unit: 3624

37. The business process according to Claim 35, where the activities are non-refutable by any of the one or more contracting parties to the secure contract./fig 27,28,30

38. The business process according to Claim 35, where the activities are non-refutable by a supporting party with an interest in the secure contract./ fig 24,27,28,30

39. Muftic does not explicitly disclose the activities are non-refutable by a supporting party providing recourse for improper contracts. Official notice is taken that this feature is old and well known in the e-commerce art and / or retail art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the advantage of providing liquidating and/or punitive damages for breach of contract such that damages are preset in the contract.

40. The business process according to Claim 33, where the contract rule set and initial conditions further comprise hidden events, which comprise random events generated by a trusted third party./ claim 25 of art; col 7, L 45-64 (authenticating suggests the possibility of hidden or random events by a trusted third party

Art Unit: 3624

41. The business process according to Claim 33, where the contract log further comprises simultaneous events, wherein said simultaneous events are held, controlled and verified by a trusted third party./fig 7,23,25; claim 25 of art

42. The business process according to Claim 33, where any contracting or supporting party can provide recourse in the event of problems during creation of the secure contract./claim 20 of art: verification; claim 27 of art: authorization

This action is **NON-FINAL**. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. SWasylchak whose telephone number is (703) 308-2848. The examiner can normally be reached on Monday-Thursday from 7:00 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylchak

9/27/04



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600